

### **AMENDMENTS TO THE DRAWINGS**

Please replace the drawings of Figures 1A-1E (5 sheets), filed on July 10, 2003 with the enclosed replacement sheets of Figures 1A-1E (5 replacement sheets). The Figures have been amended merely to delete the phrase "match with Figure \_\_\_\_" from the bottom of the figures to be consistent with Figure 2. Thus, no new matter is added by the amendments to the Figures.

### **REMARKS**

Applicants have amended claim 42 to recite a "method of treating a patient having an injury to or a disorder of an eye, said injury or disorder comprising degeneration of a photoreceptor cell." Support for amended claim can be found in the specification, for example, at page 116, line 29 through page 117, line 13. Thus, no new matter has been added. Support for new claims 72 and 73 can be found in the specification, for example, at pages 116-117.

Upon entry of the present amendments, claims 42-73 will be pending.

### ***Information Disclosure Statement***

Applicants provide herewith replacement copies of the Information Disclosure Statements filed 1/23/02, 4/18/02, 8/16/02, and 9/12/02, along with the stamped postcards indicating receipt by the PTO. Applicants respectfully request that the Statutory Declarations listed on the Information Disclosure Statements be considered. In an effort to expedite such consideration, Applicants provide herewith an SB/08 citing these Statutory Declarations as references HD-HL and respectfully request that the attached SB/08 be initialed as considered by the Examiner and returned to Applicants. Because copies of the Statutory Declarations were previously submitted, copies are not attached hereto.

Additionally, Applicants respectfully request that the SB/08 submitted with the Information Disclosure Statement on 3/12/02 be initialed as considered by the Examiner and returned to Applicants. A copy of the previously submitted Information Disclosure Statement and SB/08, along with the stamped postcard indicating receipt by the PTO are included herewith. Because copies of the references were previously submitted, copies are not attached hereto.

### ***Drawings***

Pursuant to the Examiner's request, Applicants submit herewith new figures 1A-1E, in which the phrase "match with figure \_\_\_\_" has been removed.

### ***Rejection under 35 U.S.C. § 101, Double Patenting***

Claims 42-71 were provisionally rejected under the judicially created doctrine of obvious-type double patenting as allegedly unpatentable over U.S. Patent No. 5,932,540 and U.S. Application Nos. 09/107,997; 10/084,488; 10/127,551; 10/120,398 and 10/060,523. See Paper No. 101503, page 3.

Although applicants respectfully disagree and traverse this rejection, in the interest of facilitating prosecution, applicants have amended claim 42 to recite "a method of treating a patient having an injury to or a disorder of an eye, said injury or disorder comprising degeneration of a photoreceptor cell." Applicants respectfully submit that the claims, as amended, distinguish over administration of VEGF-2 to "any individual." "Any individual" would not, *per se*, have an "***injury to or a disorder of an eye.***" For example, an individual with "perfect" vision or one who needs reading glasses would not necessarily be considered as having an "injury to or a disorder of an eye." Therefore, applicants respectfully request that the Examiner withdraw the double patenting rejection of the pending claims.

### ***Rejections under 35 U.S.C. §112, first paragraph – new matter***

Claims 42-71 are rejected under 35 U.S.C. §112, first paragraph as lacking written description for treating a patient by administering a VEGF-2 fragment. The Examiner asserts that the application only provides written description for treating a patient by proliferating photoreceptor cells. Applicants respectfully traverse. However, in the interest of furthering prosecution, claim 42 has been amended to recite "administering to a patient a polypeptide comprising amino acids 108 to 233 of SEQ ID NO:2, ***in an amount sufficient to proliferate the photoreceptor cell.***" Applicants respectfully submit that the amendment to claim 42 overcomes this rejection and request that the rejection be withdrawn.

### ***Rejections under 35 U.S.C. §112, first paragraph – enablement***

Claims 42-71 are rejected under 35 U.S.C. §112, first paragraph as lacking enablement for treating a patient by administering a VEGF-2 fragment. The Examiner

asserts that the application only provides enablement for proliferating photoreceptor cells. Applicants respectfully traverse. However, in the interest of furthering prosecution, claim 42 has been amended to recite "administering to a patient a polypeptide comprising amino acids 108 to 233 of SEQ ID NO:2, ***in an amount sufficient to proliferate the photoreceptor cell.***" Applicants respectfully submit that the amendment to claim 42 overcomes this rejection and request that the rejection be withdrawn.

### ***Rejection under 35 U.S.C. §§ 102 and 103***

Claims 42-71 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 5,932,540 or U.S. Patent No. 6,130,071.

As discussed above, the claims have been amended to recite "a method of treating a patient having an injury to or a disorder of an eye, said injury or disorder comprising degeneration of a photoreceptor cell." Applicants respectfully submit that the claims, as amended, distinguish over the cited references. None of the cited references teach administration of VEGF-2 to an individual having an injury to or a disorder of an eye.

For a reference to anticipate a claim under the doctrine of inherency, the missing element must be present as a matter of certainty. "The mere fact that a certain thing or characteristic *may* result from a given set of circumstances is not sufficient." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991) (emphasis added); *Rapoport v. Dement*, 254 F.3d 1053 (Fed. Cir. 2001).

The certainty required by the courts in sustaining an inherency rejection is not present in the instant case. None of the cited references teach administration of VEGF-2 to an individual having an injury to or a disorder of an eye. Consequently, the claim limitation that the individual have ***an injury to or a disorder of*** an eye is not present in the cited references ***as a matter of certainty***. "Any individual," and "people with 'perfect' vision" would not experience ***an injury to or a disorder of*** an eye. Therefore, applicants respectfully request that the Examiner withdraw the rejection of the pending claims under 35 U.S.C. §§102 and 103.

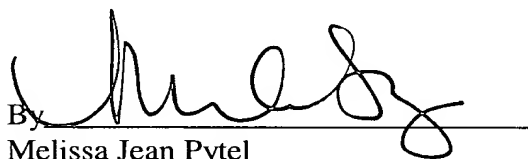
### *Conclusion*

The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Applicants believe that there are no fees due in connection with the filing of this paper. However, should a fee be due, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Dated: Dec. 9, 2003

Respectfully submitted,

By 

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Enclosures  
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